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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,131	03/30/2001	Carl M. Ellison	42390P8110	6846

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EXAMINER

NGUYEN, MINH DIEU T

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/823,131

Applicant(s)

ELLISON ET AL.

Examiner

Minh Dieu Nguyen

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 5, 8, 14 and 21-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7, 9-13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the communication dated July 11, 2005 with the amendments to claims 1 and 11 and the cancellation of claims 5, 8, 14 and 21-23.

Response to Arguments

2. The indicated objection to allowability of claims 5 and 14 is withdrawn in view of the newly discovered reference(s) to Walsh et al. (5,956,481). Rejections based on the newly cited reference(s) follow.

3. Applicant's arguments filed July 11, 2005 have been fully considered. However, upon further search, a double patenting rejection is applied to the instant application and a new ground(s) of rejection is made of Spear (6,611,925), Garrison et al. (EP 1069745 A1), and Walsh et al. (5,956,481).

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 3-4, 9, 11 and 19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 6, 9-10, 19 and 22 of copending Application No. 09/822986. Although the conflicting claims are not identical, they are not patentably distinct from each other because they discuss about the same subject matter which checks and verifies file integrity.

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of including a version number of the file analyzer in the digital signature as claimed in copending application no. 09/822986 so as to enhance the integrity of file checking.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 6-7, 9-13 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spear (6,611,925) in view of Garrison et al. (EP 1069745 A1) and further in view of Walsh et al. (5,956,481).

a) As to claims 1 and 11, Spear discloses a method and system for identifying items after they have been scanned by a virus scanner and for confirming that an item has been previously scanned for computer viruses and has not been altered since it was scanned (col. 2, lines 33-37) comprising a file analyzer to perform a scan operation on an incoming file (col. 6, lines 6-7) and produce a scanning result (col. 2, lines 65-66; i.e. certificates containing scanning result) and a signature generator to produce a digital signature (col. 4, lines 65-66), inclusive of the scanning result, of a digital signature chain, the digital signature chain is verified prior to accessing the incoming file (Fig. 2, elements 212 and 214; i.e. Globally Unique Identifier (GUI) is used to search for a signed certificate).

Spear discloses a time stamp providing information of the scan operation for insertion into the digital signature chain (col. 4, lines 39-46, in particular lines 43-44).

Spear also discloses verifying digital signature prior to accessing the file, the verifying includes determining whether contents of a digital signature associated with the digital signature chain include a message regarding the integrity of the file (Fig. 2, element 214; Fig. 3, element 316, col. 7, lines 31-46).

Spear does not disclose without the accompanying digital signature, access to the incoming file is precluded by the file analyzer, he does state a digital signature functions like a hand-written signature does for printed documents (col. 4, lines 57-59).

Garrison discloses each computer file having an associated unique digital signature and only allows access to each computer file if their associated digital signatures are valid (Abstract). Garrison further discloses digital signature is used not

only as to 'authentication', guaranteeing that a digitally signed 'document' does in fact originate from the party whose signature the document bears but also as to 'integrity', guaranteeing that the contents of the document have not been tampered with since the originating party digitally signed the document (page 3, paragraph [0020]).

Both Spear and Garrison disclose the importance of using digital signatures in securely serving computer files.

It would be obvious to one of ordinary skill in the art at the time of the invention to implement the use of preventing access to the incoming file if the file does not have the associated digital signature in the system of Spear as Garrison teaches so as to improve the security of the files.

Spear and Garrison do not disclose a file analyzer outputs the scanning result and the scanned file to accompany a digital signature chain.

Walsh discloses the scanning result and the scanned file are outputted to accompany a digital signature chain (col. 15, lines 58-62).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of outputting the scanning result and the scanned file as Walsh teaches in the system of Spear and Garrison so as to better assist file checking process.

b) As to claims 2 and 12-13, the examiner uses the same rationale as applied to part of claim 1.

It would be obvious to one of ordinary skill in the art at the time of the invention to implement the use of preventing open to the incoming file if the verified, associated

digital signature chain indicates an unacceptable file integrity in the system of Spear so as to improve the security of the files.

c) As to claim 3, Spear as modified discloses the incoming file being opened is an executable program (Abstract) and the same rationale is used as applied to claim 2, the executable program is prevented from being opened, i.e. prevented from being executed.

It would be obvious to one of ordinary skill in the art at the time of the invention to implement the use of preventing execution of the incoming file if the verified, associated digital signature chain indicates an unacceptable file integrity in the system of Spear so as to improve the security of the files.

d) As to claim 4, Spear as modified discloses the incoming file is accessed if the verified digital signature chain indicates acceptable file integrity (col. 3, lines 26-27).

e) As to claims 6 and 17, Spear as modified discloses the apparatus is employed within a platform coupled to a local area network that a platform providing the incoming file is coupled to (Fig. 1).

f) As to claim 7, Spear as modified discloses the apparatus is employed within a platform coupled to an enterprise network, not a wide area network.

Walsh discloses the apparatus is employed within a platform coupled to a wide area network (Fig.1, elements 20 and 52).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of coupling the system to a wide area network in the system of Spear and Garrison as Walsh teaches so as to cover broader area.

g) As to claims 9-10, the examiner takes official notice that use of a chipset for integrating a second control unit coupled to first control unit is known in the personal computer systems and second control unit (i.e. I/O controller) including a token bus interface (i.e. an interface connecting to a token device like smart card reader which could be connected via serial port or USB).

Personal computer systems typically include a motherboard for mounting at least one microprocessor and other integrated circuits such as memory controller, I/O controller.

I/O controller includes standard buses like ISA, EISA, AGP, PCI and USB.

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of single chip for integrating first and second control unit in the system of Spear and Garrison so as to make a compact circuit and save plug-in slots for other adapter cards in the computer system.

h) As to claims 15 and 16, Spear as modified discloses the digital signature chain includes at least one digital signature and at least one certificate (Fig. 2, elements 207, 209) and verifying the digital signature chain includes accessing contents of one certificate to determine if the signatory is authorized (col. 2, lines 61-63) and accessing contents of one digital signature to determine the integrity of the file (col. 4, lines 57-63).

i) As to claim 18, Spear as modified discloses the timing information to identify a time that a scan operation is conducted when checking the file (col. 4, lines 39-46, in particular lines 43-44)

j) As to claim 19, Spear as modified discloses the scanner is one of a virus detector, an intrusion detector, and a file integrity checker (col. 1, lines 7-10; i.e. referred collectively as "computer viruses").

k) As to claim 20, Spear as modified discloses the file contains at least one of a code and a data (col. 1, lines 22-23).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dieu Nguyen whose telephone number is 571-272-3873. The examiner can normally be reached on M-F 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

Minh Dieu Nguyen
Examiner
Art Unit 2137

mdn
8/2/05


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER